

### **REMARKS**

In response to the Office Action mailed August 22, 2006, Applicants respectfully request reconsideration. To further the prosecution of this application, amendments have been made in the claims, and each of the rejections set forth in the Office Action has been carefully considered and is addressed below. The claims as presented are believed to be in condition for allowance.

Claims 1-18 were previously pending in this application. Claims 1-6, 8-10 and 18 are amended herein. Claims 7 and 11-17 are cancelled without prejudice or disclaimer. Claims 19-39 have been added. As a result, claims 1-6, 8-10 and 18-39 are pending for examination, with claims 1, 9, 10 and 18 being independent. No new matter has been added.

### **Telephone Interview With Examiner**

Applicants' representatives thank Examiner Ly for the courtesies extended in granting and conducting a telephone interview on November 17, 2006. The substance of the interview is summarized herein.

During the interview, Applicants' representatives provided an overview of one embodiment of the invention which relates to an apparatus comprising, *inter alia*, a control unit which detects a reproduction status of a plurality of content data items (e.g., a period for which each of the content data items, which may be music, video or other content files, has been played) and selects a content data item depending on its reproduction status; and a communication unit which transmits a list showing the selected content data item to another apparatus. Applicants' representatives explained that, in an exemplary implementation wherein the apparatus comprises a media (e.g., music) player, selection of a media file based on its reproduction status may allow, for example, a list of recommended media files to be assembled automatically, as a user employs the device in the normal course by playing various media files, without requiring any overt action by the user. The recommended media list may be transmitted to another media player, such that it may be shared by users of different media players.

Applicants' representatives then requested that the Examiner explain how the limitations of the independent claims are believed to be met by the prior art of record. In this respect, each independent claim is rejected under 35 U.S.C. §103(a) as purportedly being anticipated by a combination of U.S. Patent Publication No. 2002/0090206 to Kikuchi et al. ("Kikuchi") and U.S. Patent Publication No. 2002/0132612 to Ishii ("Ishii"). Neither Kikuchi nor Ishii discloses, as an example, the selection of a content data item from a plurality of content data items based on a reproduction status of the content data item.

The Examiner agreed that neither Kikuchi nor Ishii meets the limitations of the currently pending independent claims. The Examiner requested that a formal response be submitted for his consideration.

#### Rejections Under 35 U.S.C. § 112

##### A. Claims Rejected Under 35 U.S.C. § 112, ¶1

Claims 1, 7-10, 12, 14, 15 and 18 are rejected under 35 U.S.C. § 112, ¶1, for purportedly failing to comply with the written description requirement. Specifically, the Office Action contends that claim limitations relating to a "reproduction status," "second data processing apparatus" and "content identification" are not described in Applicants' specification in such a way as to reasonably convey to one of skill in the art that the inventor had possession of the claimed invention at the time the application was filed. Applicants respectfully traverse this rejection.

Applicants' specification provides support for the limitation relating to a "reproduction status." Specifically, Applicants' specification describes an embodiment of the invention wherein the generation of a recommended tune list is based on a reproduction status of each of a plurality of tunes (e.g., whether each tune has been reproduced continuously for longer than a predetermined time period, or has been designated by a user as a recommended tune, etc.) (p. 16, lines 4-15). An example of a content data item being selected based on its reproduction status is described in significant detail with reference to Fig. 8 (see, e.g., p. 22, line 3 – p. 25, line 6). For example, Fig. 8 includes steps S3-S6, which provide for a reproduced tune being selected as a recommended tune if the reproduced tune is reproduced continuously for a predetermined period, or is added to a

favorites list by a user. Consequently, Applicants' specification provides support for the limitation relating to a "reproduction status."

Similarly, Applicants' specification provides support for the limitation relating to a "second data processing apparatus." Specifically, Applicants' specification describes an embodiment of the invention wherein a portable terminal unit (i.e. an apparatus) includes a central processing unit (CPU) which the specification makes clear is configured for data processing, such that the portable terminal unit comprises a data processing apparatus (p. 13, lines 21-24). The specification also describes several embodiments wherein communication between a first portable terminal unit and second portable terminal unit enables a transfer of recommended tune lists. For example, Fig. 9 depicts a first data processing apparatus 11-1 in communication with a second data processing apparatus 11-2 (see, e.g., p. 26, line 2 – p. 27, line 8). Fig. 12 depicts a process which may be performed to communicate a recommended tune list from a first data processing apparatus to a second data processing apparatus (see, e.g., p.28, line 1 – p.32, line 20). Hence, Applicants' specification also provides support for the limitation relating to a "second data processing apparatus."

The limitation relating to "content identification" has been removed from the claims via amendments made herein to independent claims 1, 9, 10 and 18.

In view of the foregoing, Applicants respectfully submit that claims 1, 9, 10 and 18, and the claims that depend therefrom, satisfy the written description requirement. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1, 8-10, 12, 14, 15 and 18 under 35 U.S.C. § 112, ¶1.

B. Claims Rejected Under 35 U.S.C. § 112, ¶2

Claim 7 is rejected under 35 U.S.C. § 112, ¶2 for purportedly omitting essential steps, such omission amounting to a gap between the steps. Claim 7 is cancelled herein without prejudice or disclaimer. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 112, ¶2.

Claim Rejections Under 35 U.S.C. § 101

Claims 10 and 17 are rejected under 35 U.S.C. § 101 for purportedly failing to recite statutory subject matter. Specifically, the Office Action contends that claims 10 and 17 recite a program *per se*. Claim 10 is amended herein to recite at least one computer-readable medium having instructions encoded thereon which, when executed by a data processing apparatus, performs a method. Claim 17 is cancelled without prejudice or disclaimer.

Claims 11 and 16 are rejected under 35 U.S.C. § 101 for purportedly failing to produce a useful and tangible result. Claims 11 and 16 are cancelled herein without prejudice or disclaimer.

In view of the foregoing, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 101.

Priority Claim

In support of the claim to priority under 35 U.S.C. § 119, Applicants submit a translation of the priority document (i.e. Japanese Patent Application No. JP-2002-212661) with this response.

Claim Objections

The Office Action objects to claims 3 and 14 for purported informalities. Specifically, the claim 3 is objected to for reciting “a content data item.” As suggested by the Office Action, claim 3 is amended herein to recite “the content data item.” Claim 14 is cancelled.

In view of the foregoing, Applicants respectfully request the withdrawal of the objections to the claims.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-18 are rejected under 35 U.S.C. § 103(a) as purportedly being obvious in view of a combination of U.S. Patent Publication No. 2002/0090206 to Kikuchi et al. (“Kikuchi”) and U.S.

Patent Publication No. 2002/0132612 to Ishii ("Ishii"). Applicants respectfully traverse this rejection, as the claims, as amended, patentably distinguish over the asserted combination.

A. Claim 1

Claim 1 recites a data processing apparatus. The data processing apparatus comprises a reproducing unit configured to reproduce a plurality of content data items; a control unit configured to detect a reproduction status of each content data item being reproduced by said reproducing unit, and to select a content data item from said plurality of content data items depending on a reproduction status of said content data item; and a communication unit configured to transmit to another data processing apparatus a list which shows said selected content data item.

The Office Action contends that Kikuchi discloses all of the limitations of claim 1 except for a communication unit configured to transmit to another data processing apparatus a list which shows a selected content data item. The Office Action alleges that Ishii discloses a communication unit which satisfies this limitation of claim 1. The Office Action also contends it would have been obvious at the time of the invention to modify the system disclosed by Kikuchi according to the disclosure of Ishii, so as to enable a user of a second device to receive content reproduced by a first device.

Without conceding the propriety of the asserted combination, Applicants respectfully submit that the prior art of record fails to disclose or suggest several of the limitations recited by amended claim 1. For example, neither Kikuchi nor Ishii disclose or suggest a control unit configured to detect a reproduction status of a plurality of content data items reproduced by a reproducing unit, and select a content data item from the plurality of content data items depending on a reproduction status of the content data item. In rejecting previously pending claim 1, the Office Action contends that Kikuchi discloses this limitation, but fails to reference any portion of Kikuchi in support of this contention. This is a failure to provide a detailed explanation of how the asserted references meet the claim limitations, as required by M.P.E.P. §706.02 (j)(A) and 37 C.F.R. §1.104(c)(2).

Contrary to the Office Action's assertion, Kikuchi fails to disclose or suggest selecting a content data item from a plurality of content data items depending on a reproduction status of the content data item. Kikuchi discloses a recording medium on which video, audio and management

data is recorded in a hierarchical structure consisting of program chains, programs, cells and packs (Abstract). According to Kikuchi, this structure overcomes limitations of the Moving Picture Experts Group (MPEG) data compression format, enabling the medium to deal with multiple data item classifications and to reproduce certain data items partially (§§[0004]–[0005], [0011]–[0012]). Kikuchi discloses the recording of video data on the medium in the form of a series of cells, and playback instruction information in the form of packets (§[0139]). Kikuchi also discloses the reproduction of a video data item by transferring data from the medium to RAM for decoding (§§[0088]–[0089]). Kikuchi further discloses detecting the status of a reproduction of a single video data item (see, e.g., §[0218]). However, a thorough review of Kikuchi reveals that selecting a content data item from a plurality of content data items depending on a reproduction status of the content data item, as required by claim 1, is neither disclosed nor suggested.

Ishii fails to remedy this deficiency of Kikuchi. Ishii discloses a data transmission-reception system wherein a first communication device transmits “outgoing data” that includes content identification data to a second communication device, and the second communication device in turn transmits content data identified by the content identification data to a third communication device (Abstract). The first and third communication devices may, for example, be mobile phones, and the second communication device may be a server device (§[0033]). Ishii discloses that the system may allow one user of a mobile phone to transmit time-sensitive content, such as greeting messages (e.g., an invitation to a party), to other mobile phone users more effectively than using conventional techniques (§[0007]). For example, Ishii discloses that this technique overcomes limitations associated with conventional communication techniques such as email, wherein a first user must hope that other users receive and open their email in time to receive and respond to the time-sensitive content (§§[0003]–[0008]). Ishii, however, fails to disclose or suggest anything at all relating to selecting a content data item from a plurality of content data items depending on a reproduction status of the content data item.

In addition, because neither Kikuchi nor Ishii discloses or suggests a content data item selected depending on its reproduction status, these references necessarily fail to disclose or suggest transmitting a list which shows a content data item selected depending on its reproduction status, as required by claim 1.

In view of the foregoing, Applicants respectfully assert that claim 1 patentably distinguishes over the prior art of record, such that the rejection of claim 1 under 35 U.S.C. § 103(a) as purportedly being unpatentable in view of a combination of Kikuchi and Ishii should be withdrawn.

Claims 2-6, 8, and 19-21 depend from claim 1 and are allowable for at least the same reasons.

B. Claim 9

As amended, claim 9 recites a data processing method for use with a data processing apparatus. The method comprises steps of, *inter alia*, detecting a reproduction status of each of a plurality of content data items being reproduced; selecting a content data item from the plurality of content data items depending on a detected reproduction status of the content data item; and transmitting a list which shows the selected content data item to a second data processing apparatus.

It should be clear from the discussion above relating to claim 1 that the asserted combination of Kikuchi and Ishii fails to disclose or suggest a data processing method that satisfies the limitations of claim 9. Accordingly, claim 9 patentably distinguishes over the asserted combination, such that the rejection of claim 9 under 35 U.S.C. § 103(a) as purportedly being unpatentable in view of a combination of Kikuchi and Ishii should be withdrawn.

Claims 22-30 depend from claim 9 and are allowable for at least the same reasons.

C. Claim 10

As amended, claim 10 recites at least one computer-readable medium having encoded thereon a program comprising executable instructions for performing a method substantially similar to the method of claim 9. For the reasons discussed above with reference to claims 1 and 9, claim 10 patentably distinguishes over the asserted combination of Kikuchi and Ishii, such that the rejection of claim 10 under 35 U.S.C. § 103(a) as purportedly being unpatentable in view of a combination of Kikuchi and Ishii should be withdrawn.

Claims 31-39 depend from claim 10 and are allowable for at least the same reasons.

D. Claim 18

As amended, claim 18 recites a data processing system having a first data processing apparatus and a second data processing apparatus. The first data processing apparatus comprises, *inter alia*, a first control unit configured to detect a reproduction status of each of a plurality of content data items being reproduced at a reproducing unit, and to select a content data item from the plurality of content data items depending on a reproduction status of the content data item. The first data processing apparatus further comprises a first communication unit configured to transmit to the second data processing apparatus a first list which shows the selected content data item.

It should be clear from the discussion above with reference to claim 1 that the asserted combination of Kikuchi and Ishii fails to disclose or suggest a data processing system which satisfies the limitations of amended claim 18. Accordingly, claim 18 patentably distinguishes over the asserted combination, such that the rejection of claim 18 under 35 U.S.C. § 103(a) as purportedly being unpatentable in view of the combination of Kikuchi and Ishii should be withdrawn.

New Claims

New claims 19-39 are provided to further define Applicants' contribution to the art. Claims 19-21, 22-30 and 31-39 depend from independent claims 1, 9 and 10, respectively. Each of claims 19-39 is patentable for at least the same reasons as those discussed above with reference to the respective independent claim.



Conclusion

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the application in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Dated: 11-17-06

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